

### **REMARKS/ARGUMENTS**

In response to the Office Action of May 6, 2005 rejecting pending claims 1 and 3, the Applicants respectfully request reconsideration of the rejected claims. Only claims 1 and 3 are pending.

#### **The Rejection of Claims 1 and 3**

The Office Action has rejected claims 1 and 3 under the provisions of 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,926,208 (Noonen, et al, hereinafter "Noonen") in view of U.S. Patent 6,434,196 (Sethuraman, et al., hereinafter "Sethuraman") and an article entitled "Video DSP Architecture for MPEG2 CODEC" by T. Araki, et al. (hereinafter "Araki") and U.S. Patent 6,038,580 (Yeh, hereinafter "Yeh"). The Applicants respectfully traverse the rejection.

#### **The Cited Prior Art Does Not Disclose The Features Of Amended Claim 1**

The Applicants respectfully submit that the cited prior art does not disclose the features of amended claim 1. More specifically, there is no disclosure in any of the cited references of a SIMD unit and a VLC unit that are configured to be connected to an external memory through an internal data bus and an external data interface regardless of the processor in order to be program-controlled by an outside unit. Accordingly, a rejection of amended claim 1 would be improper.

**The Office Action Fails to Establish to a *Prima Facie* Case of Obviousness**

It is also respectfully submitted that the rejection of claim 1 in the May 6, 2005 Office Action fails to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, a rejection made under 35 U.S.C. § 103 must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**There is No Motivation to Combine the Cited Prior Art References**

It is respectfully submitted that the four cited prior art references taken either alone or in combination do not recognize the problem solved by the Applicants' claimed invention or include all the features of amended claim 1. More specifically, the Applicants' claimed invention solves the unrecognized problem of wasted clock cycles of the type illustrated in Figs. 6-8. Moreover, it is respectfully submitted that only a person skilled in the art who had access to the present application would be motivated to combine the teachings of the four cited prior art references in order to solve the

unrecognized problem disclosed in Applicants' specification. In other words, the only motivation to combine the four cited references in the way suggested in the Office Action is gleaned from the hindsight provided by Applicants' specification.

The Applicants respectfully submit that the Office Action is based upon a selective combination of features found in the four references, and that such selective combining is impermissible. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985), "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." It is respectfully submitted that the Office Action cites the Noonen patent, and then utilizes the present application as a road map to selectively replace various features of the Noonen reference.

The Office Action admits that Noonen does not disclose an SIMD processor, but alleges that it would be obvious to substitute the SIMD processor of Sethuraman for the processor of Noonen. The Office Action admits that Noonen and Sethuraman do not disclose a VLC/VLD. Accordingly, the Office Action alleges that it would be obvious to substitute the VLC of Noonen with the VLC/VLD of Araki. The Office Action admits that Noonen, Sethuraman, and Araki do not disclose an integrated DCT/IDT. Accordingly, the Office Action alleges that it would be obvious to substitute the separate DCT and IDT of Sethuraman with the integrated DCT/IDT of Yeh. It is respectfully submitted that the rejection of claim 1 is a blatant string of substitutions gleaned from and motivated by

the Applicants' own patent application. The Office Action has not shown that the prior art provides the teaching or suggestion to make the claimed combination and the reasonable expectation of success. The suggestion to make the claimed combination and the reasonable expectation of success cannot be based on Applicants' disclosure. Accordingly, it is respectfully submitted that claim 1 is patentable over the impermissible combination of references cited against claim 1.

### **Dependent Claim 3**

It is also respectfully submitted that claim 3, which depends from claim 1, is patentable over the cited prior art for at least the same reasons as claim 1.

### **Conclusion**

Accordingly, it is respectfully submitted that the pending claims are allowable over the cited prior art for the reasons described above, and the Examiner is respectfully requested pass the present case to allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard J. McGrath (Reg. No. 29,195) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: October 5, 2005

Respectfully submitted,

By 

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